

## REMARKS

By this amendment, claims 1 and 3 are amended. Support can be found in the specification as filed, for example, in original claim 20 and in the description at page 4, first paragraph; page 5, lines 13 and 14; page 9, last paragraph; and page 14, lines 11-17. No issue of new matter arises.

### ***Rejection under 35 USC §103(a)***

Claims 1, 3-5, 8, 9, 12, 13, 16-20, 49 and 50 were rejected under 35 USC §103 as allegedly being obvious over Gertler in view of Reinhard and Evangelista. The Advisory Action indicated that the Office considered the part e) as "merely an intended use of the compound."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

The claims as amended no longer recite "use", thereby removing the "broadest reasonable" interpretation as "merely an intended use".

The final requirement for establishing a *prima facie* case of obviousness is clearly not met.

The applied references fail to teach or suggest any action of "identifying the chemical compound detected as a potential medicament for treating a disorder selected from the group consisting of a cardiovascular disorder, an inflammatory disorder, and a disorder of blood vessels" as recited in the claims. No *prima facie* case of obviousness has been established.

Accordingly the claims are deemed patentable over the applied art. Reconsideration and withdrawal of this rejection are respectfully requested.

To the extent that the Advisory Action alleges: "Compounds identified by Gertler's method are expected to have the same properties as those compounds identified by the instant method because the method of identifying the compounds is the same." applicants respectfully submit that the compounds *per se* are not claimed. The novelty or obviousness of any compound (whether identified by Gertler or another) is not an issue of patentability of the instant claims. For at least this additional reason reconsideration and withdrawal of this rejection are deemed proper.

Another aspect of the rejection as stated in the Advisory Action was related as follows:

"There are no active steps in the method that lead one to identify compounds for possible use of treating the claimed conditions as opposed to compounds for treating other conditions. The mental step of part e) is not supported by the active steps because the active steps are not specific to the identification of compounds specific for treating the claimed conditions."

Applicants respectfully submit that part e) is an active step. "Identifying" is an activity. The recited activity is neither taught nor suggested by the art as applied. Compounds identified pursuant to part e) and preceding actions would constitute a limited set of compounds suitable for developing to treat "a disorder selected from the group consisting of a cardiovascular disorder, an inflammatory disorder, and a disorder of blood vessels." The applied art fails to teach or suggest any process that results in such a set. For this additional reason reconsideration and withdrawal of this rejection are once more respectfully requested.

### **Conclusion**

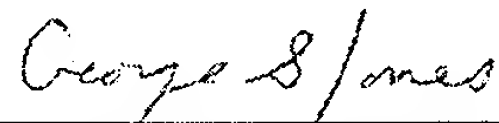
In view of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of all pending rejections. Applicants respectfully submit that the application is now in condition for allowance and request prompt issuance of a Notice of Allowance. Should the Examiner believe that anything further is desirable that might put the application in even better condition

for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

**Fees**

No fees not otherwise provided for are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account no. 18-1982 for any underpayment, or to credit any overpayments.

Respectfully submitted,



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